

Bt
Sul
D1

data, the infrastructure arranged to make a data service available in a standardized format, the infrastructure including interfaces via which the data in the standardized format is adapted to the data processing capabilities of the terminal device, the terminal device comprising:

an arrangement configured to transmit a request signal to the infrastructure via which data is requested from the infrastructure and with which information concerning the data processing capabilities is transmitted via the terminal device to the infrastructure.--.

REMARKS

I. Introduction

Claims 8 to 16 are pending in the present application, with new claims 15 and 16 having been added herein. No new matter has been added. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited reference.

Applicants note that the Office Action summary does not indicate an acknowledgment of the claim for foreign priority or an indication of whether all of the copies of the certified copies of the priority documents have been received from the International Bureau. The present application claims priority to Application No. 197 50 361.6, filed in the Federal Republic of Germany on November 14, 1997. A claim for priority was made, inter alia, in the Combined Declaration and Power of Attorney for Patent Application filed on May 15, 2000. A copy of the certified copy of the priority application is believed to have been submitted to the Office by the International Bureau. Applicants therefore respectfully request acknowledgment of the claim for foreign priority and for an indication of whether the copy of the certified copy of the priority application has been received from the International Bureau.

II. Objection to the Drawings

The drawings have been objected for allegedly failing to comply with 37 C.F.R. § 1.84(p)(4). In particular, the Office Action asserts that reference character "3" is in error because it designates both an infrastructure and a data

provider. In addition, it is asserted that Figure 1 should be designated with a legend "Prior Art".

With respect to the first objection to the reference character "3", it is noted that the specification indicates that the infrastructure and the data provider may be the same entity where it states that "[d]ata users 1,2, i.e., terminal devices 1, 2, are paired with a data provider 3, i.e., ***an infrastructure 3.***" Specification, page 2, lines 28 to 29 (emphasis added). Thus, in the exemplary embodiments depicted in Figures 1 and 2, the infrastructure is the data provider and they have the same reference number. Therefore, it is respectfully submitted that the reference character "3" in Figures 1 and 2 is not in error.

With respect to the second objection, Figure 1 has been amended to include a legend of "Prior Art". Approval of this amendment to Figure 1 is respectfully requested.

III. Rejection of Claims 8 to 14 Under 35 U.S.C. § 103(a)

Claims 8 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,949,492 ("Mankovitz"). Applicants respectfully submit that Mankovitz does not render obvious the present claims for the following reasons.

Independent claim 8 recites a method for transmitting information between an infrastructure and data users in which the infrastructure includes a service provider, the data users include terminal devices in a motor vehicle, and the data users have specific data processing capabilities, the method including making a data service available in a standardized format, and using the infrastructure and adapting data in the standardized format to the data processing capabilities of the data users via the interfaces situated in the infrastructure.

Independent claim 11 recites a terminal device for a reception of data from an infrastructure having specific data processing capabilities for processing the data, the infrastructure making a data service available in a standardized format and the infrastructure includes interfaces via which the data in the standardized format is adapted to the data processing capabilities of the terminal device, the terminal device including means for transmitting a request signal to the infrastructure via which data is requested from the infrastructure and with which information

concerning the data processing capabilities is transmitted via the terminal device to the infrastructure.

Mankovitz purportedly relates to an apparatus and method for ordering supplemental information about programs. In the Office Action, it is asserted that Mankovitz discloses an infrastructure that includes interfaces via which the data is adapted to the data processing capabilities of the terminal device. However, the sections that the Office Action cites in support of this assertion do not disclose this feature, but rather, merely disclose tuner and clock devices located at the portable radio/recorder unit 100. It is thus not understood how these features disclose either i) an interface at an infrastructure, or ii) an interface which adapts data from a standardized format to a format adapted to the capabilities of a terminal device.

To sustain an obviousness rejection, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Since Mankovitz simply does not disclose an interface located at an infrastructure at a data provider that adapts data transmitted from the data provider to the capabilities of a particular terminal, it is respectfully submitted that it does not disclose, or even suggest, all of the limitations of claims 8 or 11, from which claims 9, 10 and 12-14 ultimately depend. It is therefore respectfully submitted that Fell does not render obvious claims 8 to 14.

In addition, Applicants also do not agree with the assertion that Mankovitz suggests that the infrastructure uses a standardized data format because the receivers "must follow the FM standard," since the FM standard refers to a transmission format for modifying an electromagnetic wave to carry a data signal and does not refer to a data format that can be adapted for different data users.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects, at best, a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art

would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Therefore, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of claims 8 to 14. It is therefore respectfully submitted that claims 8 to 14 are allowable for these reasons.

IV. New Claims

New claims 15 and 16 have been added herein without prejudice. It is believed and respectfully submitted that new claims 15 and 16 do not add any new matter and are fully supported by the present application, including the Specification.

Claim 15 relates to a method for transmitting information between an infrastructure and data users including making a data service available in a standardized format, using the infrastructure, and via interfaces situated in the infrastructure, adapting data in the standardized format to the data processing capabilities of the data users, wherein the data service includes geographic information.

It is respectfully submitted that new claims 15 is allowable for at least the same reasons given above with respect to claim 8, and for the additional reason that Mankovitz does not disclose or suggest a data service that provides geographic information.

Claim 16 relates to a terminal device for a reception of data from an infrastructure, the terminal device having specific data processing capabilities

arranged to process the data, the infrastructure arranged to make a data service available in a standardized format, the infrastructure including interfaces via which the data in the standardized format is adapted to the data processing capabilities of the terminal device, the terminal device including an arrangement configured to transmit a request signal to the infrastructure via which data is requested from the infrastructure and with which information concerning the data processing capabilities is transmitted via the terminal device to the infrastructure.

It is respectfully submitted that new claim 16 is allowable for at least the same reasons given above in support of the patentability of claims 8 and 14.

V. Conclusion

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: June 27, 2003

By:

Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646



26646

PATENT TRADEMARK OFFICE